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OFFICE OF PETITIONS

In re Application of
David C. Hacker, Stanley A. Skinner, Ensor E.
Transfeldt, Peter P. Sterrantino, and Lionel
Rupp

Application No. 10/754,493

Filed: January 12, 2004

Attorney Docket No. 2401.0146.US

Title: APPARATUS AND METHOD FOR

INTRAOPERATIVE NEURAL

MONITORING

DECISION ON PETITION UNDER
37 C.F.R. §1.47(A)

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed October 14, 2004².

On January 12, 2004, the application was deposited with a declaration identifying David C. Hacker, Stanley A. Skinner, Ensor E. Transfeldt, Peter P. Sterrantino, and Lionel Rupp as joint inventors. The declaration had been executed by each of the joint inventors save Mr. Rupp. On April 14, 2004, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration in compliance with 37 C.F.R. §1.63, as well as the surcharge associated with the late submission of an oath or declaration. This Notice set a two-month period for reply.

1A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

² The petition contains a certificate of mailing dated October 12, 2004.

With the instant petition, Petitioner has submitted the petition fee and surcharge, as well as a four-month extension of time to make timely this response. Petitioner has set forth that non-signing inventor Rupp is deceased, and that his daughter is the legal representative. Petitioner has indicated that the legal representative of Ms. Rupp has made it clear that Ms. Rupp has refused to sign the declaration.

MPEP 409.03(c), sets forth, *in toto*:

Legal Representatives of Deceased Inventor Not Available:

37 C.F.R. §1.47 should not be considered an alternative to 37 C.F.R. §1.42 or 35 U.S.C. §117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor³. However, 37 C.F.R. §1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given⁴.

Petitioner has met requirements (1) – (3) above.

Regarding the fourth requirement, it does not appear that a complete copy of the application papers was sent to the legal representative of the non-signing inventor. Where a refusal of the inventor to sign the application papers is alleged, the Office requires the Petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the specification, claims, drawings, and oath or declaration⁵. Since the non-signing inventor is dead, the Office requires these materials to be sent to his legal representative. On renewed petition, it should be established that a complete copy of the application was sent to the legal representative of the non-signing inventor, Ms. Rupp (through her counsel).

It follows that since it has not been shown that a complete copy of the application was sent to the legal representative of the non-signing inventor, one cannot refuse to sign something which one has not seen. A refusal by the legal representative of the non-signing inventor to sign an oath or declaration when the same has not been presented with the application papers does not itself suggest that she is refusing to join the application unless it is clear that she understands exactly what she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the legal representative of the non-signing inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that she is apprised of the application to which the oath or declaration is directed⁶.

Regarding the fifth requirement, the declaration cannot be accepted as it fails to contain the last known address of the deceased inventor and the citizenships of both the deceased inventor and his legal representative⁷.

³ In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955). See 37 C.F.R. §1.42 and MPEP § 409.01.

⁴ See MPEP §409.03(e)

⁵ See MPEP 409.03(d).

⁶ In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

⁷ See 37 C.F.R. §§1.63 and 1.64.


For the above reasons, the petition must be **DISMISSED**.

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.47(a)." This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski.

Any renewed petition may be submitted by mail⁸, hand-delivery⁹, or facsimile¹⁰.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.


Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁸ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁹ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

¹⁰ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.